

REMARKS/ARGUMENTS

In the Election/Restriction Requirement dated July 08, 2008, the Examiner divided the claims into what he considers five (5) distinct inventions as set forth on page 2 of the outstanding Office Action. The Examiner further required the election of a single species.

Accordingly, applicants elect Group I and the species disclosed in example 36, page 105, and claimed in claim 16 on page 188, line 18. (Preliminary Amend. Page 12, 3rd compound from the bottom). Restriction is only proper if the claims of the restricted groups are independent or patentably distinct and there would be a serious burden placed on the Examiner if restriction is not required (M.P.E.P. § 803). The burden of proof is on the Examiner to provide reasons and/or examples to support any conclusions in regard to patentable distinctions (M.P.E.P § 803). Moreover, when making a lack of unity in a national stage application, the Examiner has the burden of explaining why each group lacks unity with each other (i.e., why there is no single inventive concept) especially describing the unique technical feature in each group (M.P.E.P. 1893.03(d)).

Applicants respectfully traverse the restriction on the grounds that the Examiner has not carried out the burden of providing any reasons or examples to support conclusions that the claims of the restricted groups are patentably distinct or lack unity of invention. The Examiner asserts that Groups I-V do not relate to a single general inventive concept under PCT Rule 13.1 and 13.2 because they lack the same corresponding technical feature.

The Examiner, however, has not considered that the claims in each group are considered related inventions under 37 C.F.R. 1.475(b) in which the inventions are considered to have unity of invention. Applicants submit that while PCT Rule 13.1 and 13.2 are applicable, 37 C.F.R. 1.475(b) provides in relevant part that “a national stage application containing claims to different categories of invention will be considered to have unity of

invention if the claims are drawn to ... (3) a product, process for the manufacture of said product and/or the use of said product.

Moreover, Applicants respectfully submit that a search of all the claims would not impose a serious burden on the Office. As the Office has not shown any evidence that a Restriction Requirement should now be required when the International Preliminary Report did not, restriction is believed to be improper.

In chemical cases, a specified group of materials which do not necessarily belong to an otherwise class can be claimed together employing "Markush" language. The Markush practice sanctions the claiming together operable substances which could not be defined by generic language but which nevertheless have a community of chemical or physical characteristics. The member of the Markush group need only possess at least one property in common which is mainly responsible for the function of the chemical relationship. The same utility in a generic sense suffices.

Further, M.P.E.P. § 803 states as follows:

"If the search and examination of an entire application can be made without a serious burden, the Examiner must examine it or the merits even though it includes claims to distinct and independent inventions."

Applicants submit that a search of all the claims would not constitute a serious burden on the Office. In fact, the International Search Authority has searched all the claims together.

For the reasons set forth above, applicants request that the Restriction Requirement be withdrawn.

Applicants request that if the invention of Group I is found allowable, the withdrawn groups, which include the limitation of allowable claims be rejoined M.P.E.P. § 821.04.

Divisional applications filed through claiming the non-elected species should not be subject to double-patenting ground of rejection, 35 USC 121, *In re Joyce*, (Comr. Pats 1957) 115 USPQ 412.

Applicants further request that should the elected species be found allowable, the Examiner expand the search to include the non-elected species.

Applicants submit that the above-identified application is now in condition for examination on the merits and an early notice of such action is earnestly solicited.


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